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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,480	05/18/2001	Kazuhiro Takeda	1046.1252	4507

21171 7590 07/14/2004

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EXAMINER

STEVENS, ROBERT

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,480

Applicant(s)

TAKEDA, KAZUHIRO

Examiner

Robert M Stevens

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/18/2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14 are pending in Application No. 09/859,480, entitled "Document Negotiation", filed 5/18/2001, and claiming foreign priority to Japanese Patent Application No. 2000-371970, filed on December 6, 2000. Claims 1, 6, 10 and 14 are independent.
2. The Office acknowledges the IDS filed on 5/18/2001.

Drawings

3. The drawings are objected to because the "Destination Terminal" element of Fig. 1 is missing a reference numeral.
4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. Paragraph 0005: This paragraph is awkward and may contain misspelled words (should "set" be "send"?). Please correct all spelling/grammar/etc. errors throughout the specification.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2176

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1 - 14 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 1 and 14, there is a lack of enablement regarding "detecting a document unconformable with the document creation standard for the document destination".

Claims 2-5 are rejected by virtue of their dependency upon claim 1.

Regarding claims 6 and 10, there is a lack of enablement regarding "judging whether or not the document is conformable with the document creation standard for the document destination".

Claims 7-9 and 11-13 are rejected by virtue of their dependency upon claim 6 or claim 10, as appropriate.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claim 14 is rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 14, the scope is indeterminable. This claim is an apparatus claim (i.e., a storage medium) to a method comprised of system elements.

Further regarding claim 14, there is a lack of antecedent basis for "the document" in lines 26 and 27 of page 20. There is a lack of antecedent basis because "a document" in line 18 represents a converted document, whereas "the document" in lines 26-27 refers to an original (or unconverted) document.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-14 are rejected under 35 U.S.C. 103(a)** as being unpatentable over O'Shea (US Patent No. 6,189,045, filed Mar. 26, 1998, hereafter referred to as "O'Shea") in view of Ito (US Patent Application Publication No. 2002/0023114, filed May 8, 1998, hereafter referred to as "Ito").

Regarding independent system claim 1, O'Shea discloses:

*A document modifying system comprising:
a recording unit recording a document creation standard
corresponding to a destination of a document; (Fig. 3 #'s 22, 24, 26 and
discussion at col. 5 lines 10-25 regarding creation standards [i.e., formats]
corresponding to possible destination formats of a document)*

However, O'Shea does not explicitly disclose:

*a modifying unit detecting a document unconformable with the
document creation standard for the document destination, and*

Ito, though, discloses:

*a modifying unit detecting a document unconformable with the
document creation standard for the document destination, (Fig. 4 #P31
"document structure analyzer section") and*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

O'Shea, furthermore, does not explicitly disclose:

*modifying the document in conformity with the document creation
standard.*

Ito, though, discloses:

*modifying the document in conformity with the document creation
standard. (Fig. 4 #P32 "document conversion section")*

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit O'Shea because these references were all applicable to the same field of endeavor, i.e., format conversion of electronic documents.

Regarding claim 2, which is dependent upon claim 1, O'Shea discloses:

wherein the document creation standard contains a standard for a document format or a standard for a syntax of the document. (col. 5 lines 10-18 and 34-36, especially the portions discussing document format conversions pertaining to languages)

Regarding claim 3, which is dependent upon claim 1, O'Shea discloses:

wherein the document is a text transmitted by an electronic mail system or a text posted to news information service that accumulated on a network, (col. 1 lines 29-36 re: posting to "USENET" news groups is well known in the art) and the destination is an electronic mail address of a receiving terminal of the electronic mail system, a piece of identifying information of a group including a plurality of receiving terminals, or a piece of identifying information of news group of the information service (col. 1 lines 29-36 re: posting to "USENET" news groups is well known in the art).

Regarding claim 4, which is dependent upon claim 1, O'Shea discloses:

wherein said document modifying system is connected to a document transmission system transmitting the document, (see Abstract, which discusses republishing converted data "over the network", and col. 4 lines 42-46 discussing the providing of "data to the network communication system") and modifies the document in accordance with a command given from said document transmission system. (col. 5 line 65 continuing over to col 6 line 5, noting in particular that conversions can be performed in accordance with a profile stored by the network communication system)

Regarding claim 5, which is dependent upon claim 1, O'Shea discloses:

further comprising a communication unit transmitting the document to the destination. (col. 4 lines 52-54, discussing the sending of converted data via a network to a data consumer [i.e., a destination])

Regarding independent method claim 6, O'Shea discloses:

*A document modifying method comprising:
identifying a destination of a document; (col. 5 line 65 carrying over to col. 6 line 5, in which the destination [format] is established by a data consumer and preferably maintained in a user profile)
referring to a document creation standard corresponding to a destination of a document; (col. 6 lines 16-25, in which exemplary document creation standards are enumerated)*

However, O'Shea does not explicitly disclose:

judging whether or not the document is conformable with the document creation standard for the document destination; and

It, though, discloses:

judging whether or not the document is conformable with the document creation standard for the document destination; (Fig. 4 #P31 "document structure analyzer section") and

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

O'Shea, furthermore, does not explicitly disclose:

modifying, if the document is unconfirmable with the document creation standard, the document in conformity with the document creation standard.

Ito, though, discloses:

modifying, if the document is unconfirmable with the document creation standard, the document in conformity with the document creation standard. (Fig. 4 #P32 "document conversion section")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit O'Shea because these references were all applicable to the same field of endeavor, i.e., format conversion of electronic documents.

Regarding claim 7, which is dependent upon claim 6: Claim 7 is substantially similar to claim 2, and therefore is likewise rejected.

Regarding claim 8, which is dependent upon claim 6: Claim 8 is substantially similar to claim 3, and therefore is likewise rejected.

Regarding claim 9, which is dependent upon claim 6: Claim 9 is substantially similar to claim 5, and therefore is likewise rejected.

Regarding independent storage medium claim 10, O'Shea discloses:

A storage medium readable by a machine, tangible embodying a program of instructions executable by the machine to perform method steps comprising:
identifying a destination of a document; (col. 5 line 65 carrying over to col. 6 line 5, in which the destination [format] is established by a data consumer and preferably maintained in a user profile)
referring to a document creation standard corresponding to a destination of a document; (col. 6 lines 16-25, in which exemplary document creation standards are enumerated)

However, O'Shea does not explicitly disclose:

judging whether or not the document is conformable with the document creation standard for the document destination; and

Ito, though, discloses:

judging whether or not the document is conformable with the document creation standard for the document destination; (Fig. 4 #P31 "document structure analyzer section") and

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

O'Shea, furthermore, does not explicitly disclose:

modifying, if the document is unconformable with the document creation standard, the document in conformity with the document creation standard.

Ito, though, discloses:

modifying, if the document is unconformable with the document creation standard, the document in conformity with the document creation standard. (Fig. 4 #P32 "document conversion section")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit O'Shea because these references were all applicable to the same field of endeavor, i.e., format conversion of electronic documents.

Regarding claim 11, which is dependent upon claim 10: Claim 11 is substantially similar to claim 2, and therefore is likewise rejected.

Regarding claim 12, which is dependent upon claim 10: Claim 12 is substantially similar to claim 3, and therefore is likewise rejected.

Regarding claim 13, which is dependent upon claim 10: Claim 9 is substantially similar to claim 5, and therefore is likewise rejected.

Regarding independent storage medium claim 14, Ito discloses:

A storage medium readable by a machine, tangible embodying a program of instructions executable by the machine to perform method steps comprising:

a transmission device transmitting a document to a specified destination; (col. 6 lines 7-10, regarding the delivery of a converted document to a consumer via a network) and

a document modifying system including a recording unit recording a document creation standard corresponding to the destination of the document, (Fig. 3 #'s 22, 24, 26 and discussion at col. 5 lines 10-25 regarding creation standards [i.e., formats] corresponding to possible destination formats of a document)

However, O'Shea does not explicitly disclose:

a modifying unit detecting a document unconformable with the document creation standard for the document destination, and

Ito, though, discloses:

a modifying unit detecting a document unconformable with the document creation standard for the document destination, (Fig. 4 #P31 "document structure analyzer section") and

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

O'Shea, furthermore, does not explicitly disclose:

modifying the document in conformity with the document creation standard.

Ito, though, discloses:

modifying the document in conformity with the document creation standard. (Fig. 4 #P32 "document conversion section")

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

O'Shea, still furthermore, does not explicitly disclose:

wherein said document modifying system receives the document transmitted by said transmission device and modifies the document unconformable with the document creation standard.

Ito, though, discloses:

wherein said document modifying system receives the document transmitted by said transmission device (paragraph 0052 ["The server S retrieves ... document ... and transmits it to the proxy server P... through the network N."]), and modifies the document unconformable with the document creation standard (paragraph 0053, noting "P23 retrieves the document data F from the response [i.e., the network transmission] ... performs document conversion ... based on the document conversion processing request").

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit of O'Shea because to do so would enable a document conversion function without requiring the modification of either client or server as taught by Ito in the first sentence of the Abstract.

It also would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Ito for the benefit O'Shea because these references were all applicable to the same field of endeavor, i.e., format conversion of electronic documents.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-patent Literature

ClassNET's Internet Glossary,
<http://web.archive.org/web/19970629201300/http://www.class.net/cnhtmls/glossary.htm>
(includes WayBackMachine search results showing web page date of June 29, 1997).

Gralla, Preston, How the Internet Works, Special Edition, Ziff-Davis Press, © 1997, pp. 80, 81 and 92-95.

"J. Joshi & Associates: Complete Document Conversion Bureau",
<http://web.archive.org/web/19981205065510/http://www.jjoshi.com/Ocrling.htm> (includes WayBackMachine search results showing a web page date of Dec. 5, 1998).

LaLiberte, Daniel M., "Email does email conversion", HyperNews and Email Forum, Nov. 30, 1995
(www.hypernews.org/HyperNews/get/hypernews/email/5.html?nogifs).

US Patent Application Publications

Loschky et al	2001/0013045
Chidiac et al	2002/0069227

US Patents

Carbonell et al	6,163,785
Yamamoto et al	6,311,151
Hidding et al	6,338,076
Yalcinalp	6,507,857
Jecha et al	6,631,375
Weiss et al	6,738,951
James et al	6,742,161
Taieb	6,604,105

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M Stevens whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Stevens
Art Unit 2176
Date: July 8, 2004



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

rms